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Martin Brady et al.
Docket 0166
Serial No. 09/228,109

REMARKS

Reconsideration of this application is respectfully requested.

This application contains 12 claims, numbers 3-5 and 7-15. These claims were variously objected to, rejected under 35 U.S.C. 112, second paragraph, and rejected under 35 U.S.C. 103(a). These will be discussed in that order below.

Claim objections. Claims 3, 4, 7, 8 and 10 were objected to in the Action of June 8, 2006, because of certain informalities perceived by the examiner. As to each claim, the examiner suggested language to cure those informalities. In order to advance the prosecution of this application, the recommendations made by the examiner are each adopted in the foregoing claim amendments.

The suggested and adopted amendments have an effect upon independent claim 4 and claim 5 dependent thereon, and upon independent claim 8 and claims 9, 14 and 15, dependent thereon. The examiner stated that these claims would be allowed if the suggested amendments were adopted. Therefore, claims 4, 5, 8, 9, 14 and 15 will presumably be allowed because of the foregoing amendments.

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Rejection under 35 U.S.C. 112, second paragraph. Dependent claims 11 and 13 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded by applicants as their invention. Of particular concern is whether claims 11 and 13 define the relationship between the "scissors holder" and the "sheath."

However, counsel submits that claims 11 and 13, which the examiner asserts to be indefinite, adequately define the invention to one who is familiar with the disclosure in this application. All claims have to be read and analyzed in the context of the disclosures from which they arise. If there is any doubt, the examiner need only consider that this application was thoroughly and repeatedly examined before the examiner raised the present questions concerning the definiteness of the claims 11 and 13. The examination process included an appeal to the Board of Patent Appeals and Interferences, which allowed claims 10 through 13. Up to that point and for some time thereafter, there was never a question as to the scope of claims 11 and 13. In fact, claims 11 and 13 were the subject of a Request for Rehearing granted August 23, 2003. Obviously, previous examiners and the Board did not have difficulty understanding the scope of

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claims 11 and 13. Counsel suggests that the examiner is analyzing claims 11 and 13 in a vacuum without reference to the entire disclosure of this application. Under the circumstances, it is requested that the rejection of claims 11 and 13 under 35 U.S.C. 112, second paragraph, be withdrawn.

Rejections under 35 U.S.C. 103(a).

I. Claims 3, 7 and 10-13 stand rejected as being unpatentable over Presto in view of Davies 4,152,831 and Nielsen et al. 5,791,608 with "evidence patent" Newman 2,720,189.

The rejection based on Presto, Davies and Nielsen et al. has been discussed at length, applicants' position being stated on pages 14-23 of Appellants' Brief filed June 8, 2006. That rejection was ripe for appeal. The present rejection, if it were maintained, is unsound. The examiner's proposition that a scissors can be mounted anywhere in view of prior art, does not mean a skilled artisan will pick a can opener as the spot for the mounting.

The present rejection for the first time introduces the newly-cited Newman patent, which shows embodiments of a holder for various devices for use around an office. These include hidden grooves adapted to receive the blades of a scissor.

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Newman is simply accumulative and adds nothing missing from Presto, Davies and Nielsen et al.

II. Claims 3, 7 and 10-13 stand rejected as being unpatentable over Presto in view of Newman 2,720,189. This rejection fails for the reasons given by the Board in reversing the rejection of claims 10 through 15 and discussed in response to the rejection based on Presto, Davies and Neilsen et al. on pages 14 through 23 of Appellants' Brief filed June 8, 2006. Moreover, Newman's disclosure of internal grooves to hold a scissors clearly does not suggest any useful change in the Presto can opener, except perhaps in hindsight.


III. Claim 10 stands rejected as unpatentable over Presto in view of Zelson 6,253,662. This rejection is addressed on pages 24 and 25 of Appellants' Brief filed June 8, 2006. Here the examiner proposes the obviousness of adding a drawer to the Presto can opener because Zelson teaches a coffee maker with a drawer. Such is obvious only from familiarity with the disclosure of the instant application.

The newly cited references other than Newman have been studied but do not appear to affect the scope of the claims allowable to applicants.

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Favorable action is requested.

Respectfully submitted,


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